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09/681,441	04/05/2001	Peter Fall	VCC0031-US	4762

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EXAMINER

LUONG, VINH

ART UNIT PAPER NUMBER

3682

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/681,441
Filing Date: April 05, 2001
Appellant(s): FALL, PETER

STEVEN G. PARMELEE
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 31, 2005.

(1) *Real Party in Interest.*

The statement of the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences.*

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The statement of the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of claims.

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final.

The amendment after final has been filed on October 12, 2004 to submit replacement drawing sheets. These drawings are accepted by the Examiner.

(5) Summary of claimed subject matter.

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of rejection to be reviewed on appeal.

The Appellant's statement of the issues in the brief is incorrect. Upon reconsideration, the following rejections have been withdrawn: (a) the rejection of claims 1, 2, 5, 6, 8, 10, 14, 16-20 as being anticipated by Wolpert (US Patent No. 6,082,219); (b) the rejection of claim 15 under 35 U.S.C. 103(a) as being unpatentable over Wolpert; and (c) the rejection of claims 1-3, 5, and 8-17 under 35 U.S.C. 103 as being unpatentable over Bayer et al. (German O.S. 31 40329 A1). The only remaining rejection is the rejection of claims 1-3, 5, and 8-17 under 35 U.S.C. 103(a) as being unpatentable over Bayer et al. in view of Wolpert.

(7) Grouping of claims.

Appellant's brief does not include a statement that claims 1-3, 5, and 8-17 stand or fall together.

(8) Claims appealed.

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A correct copy of appealed claims 1-3, 5, and 8-17 appears on pages 14-17 of the Claims Appendix.

(9) Prior Art of record.

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

DE 31 40 329	Bayer et al.	04-1983
US 6,082,219	Wolpert	07-2000

(10) New prior art.

No new prior art has been applied in this Examiner's Answer.

(11) Grounds of rejection.

The following grounds of rejection are applicable to the appealed claims:

Claims 1-3, 5, and 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer et al. in view of Wolpert. This rejection is set forth on pages 8-12 in the final rejection on July 7, 2004.

(12) New ground of rejection.

This Examiner's Answer does not contain any new ground of rejection.

(13) Response to argument.

VL The examiner's response to Appellant's arguments in Paper No. 7^(final rejection) is incorporated herein by reference. In addition, the Examiner responds in the following the new arguments raised on pages 12 and 13 of the brief.

Appellant argues that a redesign of Bayer that results in placing Bayer's control cable wholly within the vehicle cab raises new unaddressed problems that deal with practicality and

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aesthetics. Thus, in turn, would clearly discourage rather than encourage one skilled in the art from making such selective combination.

The Examiner respectfully submits that contrary to Appellant's speculation, even if the redesign of Bayer as stated would raise new problems, however, these problems are easily resolved by one having ordinary skill in the art. In fact, one of the solutions is set forth, *e.g.*, in Wolpert.

Appellant further asserts that there are other specific differences between Bayer and Wolpert that would render such a pick and choose combination unobvious, *e.g.*, Bayer teaches the use of a flexible cable while Wolpert requires the use of a rigid, non-compressible rod.

The Examiner respectfully submits that Appellant does not specify the other specific differences between Bayer and Wolpert. The example that Appellant provides is unsupported by substantial evidence presented in the record. Indeed, the record shows that Bayer's flexible cable is fully equivalent to Wolpert's rod. The terms such as "rigid" and "compressible" are relative terms. One structural element can be considered as being "rigid" or "soft" relative to other elements. Moreover, virtually any thing will be compressed if enough pressure is applied to it. *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969).

With respect to Appellant's arguments about hindsight, our reviewing Court stated:

While this court indeed warns against employing hindsight, its counsel is just that – a warning. That warning does not provide a rule of law that an express, written motivation to combine must appear in prior art references before a finding of obviousness. Stated differently, this court has consistently stated that a court or examiner may find a motivation to combine prior art references in the nature of the problem to be solved. See *Pro-Mold*, 75 F.3d at 1573; *Display Techs., Inc. v. Paul Flum Ideas, Inc.*, 282 F.3d 1340, 1346-47 (Fed. Cir. 2002); *In re Huang*, 100 F.3d 135, 139 n.5 [40 USPQ2d 1685] (Fed. Cir. 1996). This form of motivation to

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combine evidence is particularly relevant with simpler mechanical technologies. *Ruiz v. A.B. Chance Co.*, 69 USPQ2d 1686 (CA FC 2004).

This record shows that the Examiner court did not use hindsight in its obviousness analysis, but properly found a motivation to combine because the two references address precisely the same problem of small, structural input and design space. See the last paragraph on page 2 of the English translation of Bayer and in Wolpert, column 1, line 51 through column 2, line 31. Hindsight is eliminated in the instant case since Bayer and Wolpert are not only in the same field of endeavor, but also solve the same problem in substantially the same way.

CONCLUSION


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Vinh T. Luong
Primary Examiner

Conferees:

SPE David Bucci and 

Primary Examiner Thomas Hannon 